

Remarks

On July 22, 2003, Applicants' attorney had a telephone interview with the Examiner of this application to discuss the outstanding claim rejections maintained in the above-identified Advisory Action. As a result of the telephone interview, Applicants were invited to submit their comments in the form of a response to the outstanding Office action.

Applicants now address each point noted in the Advisory Action, and present their comments in support of the allowance of this application as follows:

I. Rejection of Claims

The rejection of claims 43, 46 to 48, and 50 to 56 have been rejected under 35 U.S.C. §103 as being allegedly unpatentable over Samonides in view of McNaul has been maintained in the Advisory action.

A. Independent claim 43

This claim recites, inter alia, the method feature applying a film-forming material onto a surface of the pressure-sensitive adhesive while the *pressure-sensitive adhesive is in a non-final state*. This takes place within the context of forming an overlaminated PSA construction comprising: (1) a further film layer deposited over the film-forming material, and (2) a printed indicia interposed between the film-forming material and the further film layer.

As discussed at length with the Examiner during the telephone interview, a key feature of Applicants' claimed method is the fact that the film-forming material is applied to the underlying PSA material while the PSA material is in a non-final, not fully developed, not fully matured state, i.e., at a point where the PSA material not yet displays the desired final performance properties useful in the PSA construction.

Application of the film-forming material, by either the multi-step or single step processing technique specifically described in this patent application, takes place when

the PSA is in the non-final state. This occurs because, in each and every case, the PSA material is intentionally deposited onto the release surface of the removable substrate only moments before the film-forming material is applied.

As noted during the telephone interview, Samonides discloses a PSA-backed substrate comprising a basic structure of: (1) a release coated carrier; (2) a PSA material deposited on the carrier; (3) a printed indicia applied to a portion of the PSA material; and (4) a protective layer deposited over the printed indicia and exposed surface of the PSA material.

Thus, Samonides fails to disclose or even remotely suggest Applicants' basic construction because it lacks the film-forming layer interposed between the PSA and the printed indicia. This was in fact admitted to by the Examiner in the Office action dated April 5, 2002. During the interview, contrary to this admission, the Examiner presented the observation that perhaps the printed indicia of Samonides could be a film-forming material.

Applicants submit that this observation is not well founded because Samonides is silent on the types of materials useful for forming the printed indicia, which can just as easily be in the form of a conventional ink printing. Support for the fact that the printed indicia is formed from ink can be inferred from the repeated importance that Samonides places on the need to use a PSA material that is essentially dry. Samonides even discloses the use of a dryer or evaporator to further cure or dry the PSA material before printing, which further supports Applicants' position.

Further, even if the Examiner's observation was followed, and the printed indicia was considered to be Applicants' film-forming material, Samonides would then fail to disclose or suggest Applicants' claimed method because it does not teach forming a printed indicia between the film-forming material and the overlamine film material. In other words, if the Examiner relies on Samonides printed indicia to serve

as Applicants' claimed film-forming material, then the Examiner cannot too rely on the same printed indicia to serve as Applicants' claimed printed indicia.

The Examiner notes in the Advisory Action that Samonides teaches a method of making a PSA construction where the PSA is in a non-final state. While Samonides does disclose the concept of applying the PSA in the form of a water-based emulsion, it also clearly states and restates throughout the patent the importance that the PSA be very close to its final form (i.e., that it be almost "dry", see col. 5, lines 6 to 23). A careful read of this passage, and others throughout the patent, will make it very clear that the PSA in Samonides is in fact in final form when the subsequent printed indicia and protective layer is applied thereto. Further, contrary to the Examiner's assertion, Samonides says nothing about using PSA materials in the form of a hot melt to form its invention.

In view of the above, Applicants submit that Samonides does not disclose or even remotely suggest Applicants' claimed invention feature of applying the film-forming material while the underlying PSA material is in a non-final state. Rather, Samonides teaches just the opposite; namely, that the PSA material applied to the carrier should be as close to final state as possible (dry), and further that steps should in fact be taken (e.g., using dryers and evaporates) if necessary to make sure that the PSA is in its final state before applying the printed indicia.

From this, Applicants submit that one having ordinary skill in the art would not be motivated from Samonides to derive Applicants' claimed method of forming a PSA construction comprising applying a film-forming material onto the PSA material when it is not fully developed.

The Examiner relies on McNaul's disclosure of a prior art construction (col. 4, lines 8 to 25; and illustrated in FIG. 2) comprising: (1) a release liner; (2) a PSA material disposed on the release liner; (3) a layer of vinyl film on the PSA material; (3)

a printed indicia on the vinyl film surface; and (4) a protective overcoating on the printed indicia.

McNaul however is silent about how this prior art construction is made, e.g., whether the vinyl film is applied to the PSA when the PSA is in a non-final form. Further, McNaul's disclosure of its own inventions do not help in this regard as the invention embodiments disclosed therein relate to a sheet material comprising: (1) a carrier tape; (2) an application tape applied to a surface of the carrier tape; and (3) a plastic film applied to a surface of the application tape.

These invention constructions are fundamentally different from the prior art construction noted above, and are made from preformed elements, e.g., a preformed carrier tape and application tape. Thus, McNaul is silent with respect to concepts of fabrication involving forming a protective film layer over the PSA layer while the PSA layer is not fully developed.

Thus, one having ordinary skill in the art would not be motivated by the teaching of McNaul to develop a method of fabricating a PSA construction according to Applicants' claimed method comprising depositing the film-forming material while the underlying PSA material is in non-final form.

Applicants submit that since both Samonides and McNaul each alone fail to disclose or suggest this invention feature, that the combination of these two patents cannot properly render obvious that invention feature which is missing in each. Therefore, one having ordinary skill in the art would not be motivated by the combination of Samonides and McNaul to derive a method of producing a PSA construction comprising applying the film-forming material onto the PSA material while the PSA material is in a non-final state.

Applicants, therefore, submit that its invention as recited in independent claim 43 is not obvious over the combination of Samonides and McNaul, and respectfully

request that the rejection of independent claim 43, and claims 44 and 45 depending therefrom, under 35 U.S.C. §103 be reconsidered and withdrawn.

B. Independent Claim 46

This claim recites a *continuous method* for forming an overlaminated pressure-sensitive adhesive construction that involves, inter alia, the steps of: (1) applying a PSA material to a release surface; and (2) applying a film forming material onto a surface of the PSA material. As noted in the preamble of the claim, this methodology of steps is carried out in a *continuous* manner.

As noted above, the Examiner admits that Samonides fails to disclose or even remotely suggest the concept of applying a film-forming material to a surface of a PSA material, yet alone doing this as part of a continuous operation. Also, as noted above, McNaul's disclosure relating to the prior art construction fails to shed any light on how such prior art construction is fabricated, e.g., is it formed from a number of preformed elements that are each separately constructed via separate fabrication processes.

McNaul's disclosure of its own invention construction possibly indicates that the final construction may be assembled at one location from the different preformed elements. This, however, is not the same or even similar to Applicants' claimed continuous method of constructing that involves steps for fabricating the construction using the raw materials, i.e., not using preformed elements (something McNaul is silent on).

Since both Samonides and McNaul fails to disclose or remotely suggest this important claim feature, Applicants' submit that the combination of these two patents cannot render obvious that which is missing in each. Applicants, therefore, submit that one having ordinary skill in that art would not find Applicants' invention as recited in claim 46 to be obvious in view of the combination of Samonides and

McNaul, as neither provides any motivation to produce a PSA construction according to the manner claimed.

Applicants, therefore, respectfully request that the rejection of independent claim 44, and claims 46 to 48 and 50 to 56 depending therefrom, under 35 U.S.C. §103 be reconsidered and withdrawn.

II. Allowed Claims

Applicants acknowledge with appreciation the noted allowance of claims 38 to 42, and hereby accept the same

III. Allowable Claims

Applicants acknowledge with appreciation the Examiner's noted allowability of claims 44, 45 and 49 if rewritten into independent form. Applicants, however, believe that these claims are allowable by virtue of their dependence from respective independent claims 43 and 46 for the reasons presented above in Section I of this Amendment. In view thereof, Applicants elect not to rewrite these claims at the present time.

IV. Conclusion

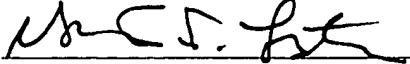
Applicants accept the allowance of claims 38 to 42, and respectfully request that the rejection of claims under 35 U.S.C.'103 be reconsidered and withdrawn, and that the remaining claims 43 to 56 pending in this patent application be passed to allowance.

Appl. No. 09/925,836
Amdt. dated July 25, 2003
Reply to Office action of 01/29/2003

The Commissioner is hereby authorized to charge any additional fees to Deposit Account No. 10-0440, or credit any overpayment to the same.

Respectfully submitted,

Date: 2/25/03


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